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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/047,911 | 01/15/2002 | Juan Pons Bolta | 3973-011491 | 2721 |

7590 12/03/2003

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EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/047,911 | Applicant(s) BOLTA, JUAN PONS | |
| | Examiner Kent L. Bell | Art Unit 1661 | |

-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on papers filed 9/11/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/11/03 are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

K. L. Bell

Detailed Action

Status of Application

Applicant's comments filed September 11, 2003 have been fully considered but are not found persuasive as to the issues set forth in this Office action.

The photographic illustrations filed September 11, 2003 have been entered. The originally filed photographic illustrations have been canceled.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 3, lines 1-3, As stated in the previous Office action mailed March 6, 2003, Applicant should set forth in the specification information relative to the instant tree's trunk including the typical and observed trunk diameter at a specified height above the ground.

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B. Page 3, line 3, Applicant states “Odd”. It appears applicant may have intended to state --Old--. Correction and/or clarification is necessary.

C. Page 3, line 25, As stated in the previous Office action mailed March 6, 2003, Applicant should set forth in the specification additional information relative to the instant tree’s petals including the typical and observed petal shape, apex, base, and margin descriptor.

D. Page 3, line 26, As stated in the previous Office action mailed March 6, 2003, Applicant should set forth in the specification additional information relative to the instant tree’s sepals including the typical and observed sepal shape, length, width, apex, base, and margin descriptor.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

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Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Claim Rejection

The Claim remains rejected under 35 U.S.C. 102(b) as being clearly anticipated by Plant Breeder's Right application number 20001110 (European Union) taken in view of the article by Bono et al. ('Clemenpons' and 'Loretina', Two Early Clementine Mandarin Mutations of Potential Interest, 174-176, 1996) and in further view of the article by Perez (Resultados Sobre La Desverdizacion En Nuevas Variedades: Clemenpons Y Loretina, 117-124, Jun-Jul 1997, for the reasons stated in the previous action.

Response to Arguments

Applicant's remarks filed September 11, 2003 have been fully considered but are not considered persuasive for the following reasons:

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Applicant argues that “These references are non-enabling publications and do not indicate public use or sale of ‘Clemenpons’ in the United States more than one year before the filing of the instant application.”. The Examiner respectfully disagrees with Applicant for the following reasons:

The PBR publication, together with public availability of the plant, i.e. Bono et al. and Perez articles (‘Clementine’ was publicly available, Bono et al. had at least one plant and so did Perez), and applicant’s own admission that plants of the instant cultivar were “publicly available after August 26, 2000, only in Spain” remarks section page 5, filed September 11, 2003, would have allowed a skilled artisan to take the teachings of either article and combine them with his own knowledge of the art to be in possession of the invention or simply obtain a plant since the plant was available (August 26, 2000).

“Prior public use or sale are the avenues by which a plant enters the public domain (*LeGrice*, page 372.)”. The “public use or sale” does not have to take place in the United States to rise to the level of a statutory bar. This argument is not persuasive for two reasons: (1) This issue was not present in *LeGrice*, and (2) This issue is not present in the instant case. The rejection is based on a publication, not prior use or sale. As stated in the previous Office action, mailed March 6, 2003, specifically page 12, “The clear wording of 35 USC 102(b) is “A person shall be entitled to a patent unless- ...(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one

Detailed Action

year prior to the date of application for patent in the United States... ” ”. “There is no requirement/restriction of the bar under 35 USC 102(b) to printed publications in this country. The second clause of 35 USC 102(b) barring public sale or use in this country is not relevant because the rejection under 35 USC 102(b) over the foreign breeder right certificate, as enabled by the Bono et al. and Perez articles, and enabled by applicant’s own admission that plants of the instant cultivar were “publicly available after August 26, 2000, only in Spain” remarks section page 5, filed September 11, 2003, would not be over public use or sale, but over a printed publication.” “In *Pentech International Inc. V. Hayduchok*, 18 USPQ2d 1337, it stated that the “on-sale-bar” must be “in public use or on sale in this country, more than one year prior to the date on the application for patent in the United States.”. *Pentech v. Hayduchok* later states “a foreign use or sale, **without a printed publication** or patent as described in 102(a), will not undermine the validity of a patent issued in the United States” (page 1343). For the instant application, the plant was described in the Plant Breeder’s Right application, when combined with

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commercial availability in a foreign country, would have enabled one skilled in the art to reproduce the claimed invention.

Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Comments

Applicant should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicant should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent L. Bell